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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,316	07/08/2003	Kevin L. Parsons	89537	9361

7590 04/15/2004

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Chicago, IL 60606

EXAMINER
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WARD, JOHN A

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,316

Applicant(s)

PARSONS, KEVIN L.

Examiner

John A. Ward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration..
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0703</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padden (US 5,893,631) in view Beinbrech (US 4,087,570)

Regarding claim 48, Padden discloses a flashlight comprising of a light emitting diode 16, a power source 23 having a first side and second side, a body 34 adapted to receive the light emitting diode and power source (figure 1), a switch 28, and a side cover.

Regarding claims 49 and 50 Padden discloses an opening 32.

Regarding claim 52, Padden discloses that the power source and first and second leads of the light emitting diodes 18, 20 are held within a support structure 36.

Regarding claims 48, 51 and 53-59, Padden does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claim 48, Beinbrech ('570) discloses an illuminated article comprising of a light source 62 that is attached to a medallion 60.

Regarding claims 51 and 53, Beinbrech discloses that the medallion may be adhesively bonded (column 4, lines 4-14).

Regarding claims 54 and 58-59, figure 9 of Beinbrech teaches that the medallion is disposed within an opening defined at least one of the side cover made of a polymer protects the medallion (column 5, lines 63-68 to column 6, lines 1-7).

Regarding claims 55-57 Beinbrech does not disclose the type of materials used to make the medallion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of a metal, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin*, **125 USPQ 416**.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Padden with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 60-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padden (US 5,893,631) in view Beinbrech (US 4,087,570)

Regarding claim 60, Padden discloses a flashlight comprising of a light emitting diode 16, a power source 23 having a first side and second side, a body 34 adapted to receive the light emitting diode and power source (figure 1), a switch 28, and a side cover.

Regarding claim 61 Padden discloses an opening 32.

Regarding claims 62-66, Padden does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claims 65 and 66, figure 9 of Beinbrech teaches that the medallion is disposed within an opening defined at least one of the side cover made of a polymer protects the medallion (column 5, lines 63-68 to column 6, lines 1-7).

Regarding claims 62-64 Beinbrech does not disclose the type of materials used to make the medallion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of a metal, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin*, **125 USPQ 416**.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Padden with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padden (US 5,893,631) in view Beinbrech (US 4,087,570).

Regarding claim 67, Padden discloses a flashlight comprising of a light emitting diode 16 having a first and second lead 18, 20, a power source having a first side and

second side 22, 23, a body 34 adapted to receive the light emitting diode and power source (figure 1), a switch 28, a side cover and an opening 32.

Regarding claims 67 and 68, Padden does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claims 67 and 68, Beinbrech discloses that the medallion may be adhesively bonded (column 4, lines 4-14).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Padden with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 69-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padden (US 5,893,631) in view Beinbrech (US 4,087,570).

Regarding claim 69, Padden ('631) discloses a flashlight comprising of a light emitting diode 16, a power source having a first and second side 22, 23, a switch 28, a body 34, and a side cover 30.

Regarding claim 75, Padden discloses that the light emitting diode 16 further comprises a first and second lead 18, 20 which are held within a structure (figure 6).

Regarding claim 79 and 80 Padden does not discloses that the cover is formed of plastic or polymer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the side cover made of a polymer, since it has been held

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that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. ***In re Leshin, 125 USPQ 416.***

Regarding claims 69-78, Padden does not disclose a medallion, or the material that it is composed of.

Regarding claims 69, 70 and 74, Beinbrech ('570) discloses a method of making a medallion that may be adhesively bonded (column 4, lines 4-14).

Regarding claims 71-73 and 76-78, Beinbrech does not disclose the size of the medallion, nor does it disclose the material composition of the medallion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of metal or the size of the medallion, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. ***In re Leshin, 125 USPQ 416.***

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Padden with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 48-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Regarding claims 48 and 50, Parsons et al discloses in claims 4 a flashlight comprising of light emitting diode, a power source, a switch, a frame, and housing.

Regarding claims 48, 51 and 53-59, Parsons et al does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claim 48, Beinbrech ('570) discloses an illuminated article comprising of a light source 62 that is attached to a medallion 60.

Regarding claims 51 and 53, Beinbrech discloses that the medallion may be adhesively bonded (column 4, lines 4-14).

Regarding claims 54 and 58-59, figure 9 of Beinbrech teaches that the medallion is disposed within an opening defined at least one of the side cover made of a polymer protects the medallion (column 5, lines 63-68 to column 6, lines 1-7).

Regarding claims 55-57 Beinbrech does not disclose the type of materials used to make the medallion.



It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of a metal, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin*, **125 USPQ 416**.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Parsons et al with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 60-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Claims 60-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Regarding claims 60 and 61, Parsons et al discloses in claim 4 a flashlight comprising of light emitting diode, a power source, a switch, a frame, and housing.

Regarding claims 62-66, Parsons et al does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claims 65 and 66, figure 9 of Beinbrech teaches that the medallion is disposed within an opening defined at least one of the side cover made of a polymer protects the medallion (column 5, lines 63-68 to column 6, lines 1-7).

Regarding claims 62-64 Beinbrech does not disclose the type of materials used to make the medallion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of a metal, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin*, **125 USPQ 416**.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Parsons et al with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 67 and 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Claims 67 and 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Regarding claim 67, Parsons et al discloses in claim 4 a flashlight comprising of light emitting diode, a power source, a switch, a frame, and housing.

Regarding claims 67 and 68, Parsons et al does not disclose a medallion, means to attach the medallion, or the type of material of the medallion.

Regarding claims 67 and 68, Beinbrech discloses that the medallion may be adhesively bonded (column 4, lines 4-14).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Parsons et al with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Claims 69-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Padden (US 5,893,631) and in view of Beinbrech (US 4,087,570).

Claims 69-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,190,018 in view of Beinbrech (US 4,087,570).

Regarding claim 79 and 80 Parsons et al does not discloses that the cover is formed of plastic or polymer.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the side cover made of a polymer, since it has been held

that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin, 125 USPQ 416.*

Regarding claims 69-78, Parsons et al does not disclose a medallion, or the material that it is composed of.

Regarding claim 75, Padden ('631) discloses a flashlight comprising of a light emitting diode 16, a power source having a first and second side 22, 23, a switch 28, a body 34, and a side cover 30.

Regarding claims 69, 70 and 74, Beinbrech ('570) discloses a method of making a medallion that may be adhesively bonded (column 4, lines 4-14).

Regarding claims 71-73 and 76-78, Beinbrech does not disclose the size of the medallion, nor does it disclose the material composition of the medallion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medallion of metal or the size of the medallion, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of a matter of obvious design choice. *In re Leshin, 125 USPQ 416.*

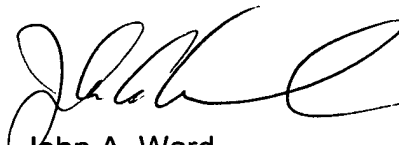
Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Parsons et al and Padden with the medallion of Beinbrech in order to provide a decorative article that illuminates in the dark (see abstract of Beinbrech).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Ward whose telephone number is 571-272-2386. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAW  
April 9, 2004



John A. Ward  
Patent Examiner AU 2875